

REMARKS/ARGUMENTS

Status

This reply is in response to the Office Action mailed December 14, 2009 in which the following rejections were set forth:

Claims 1-3, 5-9, 11 and 13-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6589,348 "*Ott*" in view of U.S. Pat. Pub. No. 20050173018 "*Herre*" and further in view of U.S. Pat. No. 5,289,947 "*Akeel*;"

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 5,855,062 "*Kendall*;"

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 4,962,724, "*Prus*;" and,

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 2,784,350, "*Sedlacsik*."

By this response, no claims have been amended, added or canceled. As such, Claims 1-13 are pending in this application.

Claim Rejections

In the Office Action, Applicant's arguments were deemed not persuasive. Applicant again traverses the rejections and requests reconsideration of the rejections in light of the following arguments.

First, Applicant submits that the rejections must fail because the effective date of *Herre* for the subject matter relied upon to make the rejection is *after* Applicant's priority date, and thus, this matter from *Herre* cannot be prior art.

The present application was filed October 7, 2005 and claims priority to PCT/EP03/06400 (filed June 18, 2003) which claims priority to German Application No. 102 33 006.9 filed July 30, 2002.

Applicant has already submitted a certified English translation and a certified copy of the priority application and thus, Applicant submits it has perfected its priority claim and *Herre* cannot be prior art under 35 U.S.C. § 102(a). *See*, MPEP § 706.02(b).

Accordingly, it is submitted that *Herre* could only be prior art under 35 U.S.C. § 102(e). *Herre* claims priority to two provisional applications, only one of which was filed before the priority date (July 30, 2002) of the present application. Specifically, only provisional application 60/378,506 has a filing date (May 7, 2002) before the priority date of the present application. In order to be entitled to this date, however, the provisional application must support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. MPEP § 2163.03 III. Applicant submits that the subject matter relied upon to make the rejection is not supported by provisional application 60/378,506.

For example, FIGS. 17-20 from *Herre*, which are used in the rejection, are not in the provisional application. Indeed, the provisional application has ***no*** figures that are even remotely similar to FIGS. 17-20 of *Herre*. Moreover, the provisional application is ***completely silent*** with respect to solvent being moved between two pigs. Accordingly, since the subject matter relied upon to make the rejection is not present in provisional application 60/378,506, the earliest effective filing date for the material would have to be ***after*** the priority date of the present application (July 30, 2002). Accordingly, *Herre*, at least with respect to the subject matter relied upon for the rejection, cannot be a reference under 35 U.S.C. § 102(e). Therefore, the rejection

of all of the claims must fail since *Herre* is not a proper prior art reference and none of the remaining references disclose the material relied upon for the rejection.

Notwithstanding the above, Applicant traverses that Office Action's position that Applicant only argued against the references individually. Indeed, Applicant argued against the combination of the references arguing that

Despite the commonality that *Ott* and *Herre* relate to a paint transport system, because the mechanism utilized by each reference are significantly different, Applicant asserts that a person having ordinary skill in the art would not look to *Herre* to compensate for *Ott*'s shortcoming to disclose cleaning the paint line with a solvent for various reasons. For instance, *Ott* discloses a two pig paint transporting system as opposed to *Herre*'s disclosure pertaining to arguably a single pig, or no pig, paint transportation system. And even if a person of ordinary skill in the art would look to *Herre* for disclosing a "cleaning process," incorporating *Herre*'s cleaning process into *Ott* would not result in Applicant's claimed invention; but rather, would result in either a paint conveyor system utilizing three pigs wherein a packet of solvent contained within the first and second pigs leads a packet of paint contained between the second and third pigs; or, *Ott* would be modified to transport the solvent between the first two pigs and paint would be pressurized through the pipe line behind the solvent. In either instance, the combination of *Ott* and *Herre* would not result in Applicant's claimed invention wherein paint is transported between two pigs on the way to the application device, and then solvent is transported between the same two pigs on the way back to the paint source. As such, the combination of *Ott* and *Herre* discloses, at most, a paint conveying system wherein only paint is conveyed between two pigs, or only solvent is conveyed between two pigs, but not paint and solvent being separately conveyed between two pigs. And thus, the combination of *Ott* and *Herre* fails to disclose paint and solvent being separately conveyed between two pigs.

See, Response to Office Action Mailed June 24, 2009, pages 7-8. Thus, Applicant argued that the combination, which lacked a motivation to combine the references, still does not result in the disclosure of the present invention.

In addition, Applicant further presented arguments directed towards the combination of the references with *Akeel*, arguing that the proposed modifications would change the principle of operation of the prior art invention being modified. *See*, Response to Office Action Mailed June 24, 2009, pages 8-10.

In sum, Applicant submits that independent claims 1 and 13 should be deemed patentable over the cited prior art. In addition, it is submitted that dependent claims 2-12 and 14-16 should be deemed patentable as they depend from independent claims that are patentable.

CONCLUSION

Based upon the above remarks, Applicant respectfully requests that all rejections be removed and all pending claims be passed to issuance.

If any additional fees are required with this communication, Applicant herein authorizes the Commissioner to deduct such fees from Deposit Account No. 50-0545.

Respectfully Submitted,

Dated: February 3, 2010

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